

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re: Werner et al. Confirmation No.: 9269
Appl No.: 10/535,763 Group Art Unit: 1638
Filed: May 20, 2005 Examiner: Page, Brent T.
For: METHOD OF CONTROLLING A CELLULAR PROCESS IN A MULTI-
CELLULAR ORGANISM

Mail Stop Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

RESPONSE TO RESTRICTION REQUIREMENT

This is in response to the Office Action dated July 2, 2007, in which the Examiner has required restriction between Group I, namely Claims 1-31 and Group II, namely Claims 32-34. The Examiner has further required that if Applicants elect the Group I claims, the selection of one origin for the protein portion from among plant, animal, or artificial proteins as set forth in claims 20-22.

Applicants hereby provisionally elect with traverse to prosecute the claims of Group I (Claims 1-31) for a protein portion from a plant protein and expressly reserve the right to file divisional applications or take such other appropriate measures deemed necessary to protect the inventions in the remaining claims and in non-elected protein portions of the Group I claims.

Applicants respectfully request that the Examiner withdraw the Restriction Requirement and examine all of the claims together in the present application because the application does not lack unity of invention for the reasons set forth below.

The Office Action indicates that the inventions of Groups I-II do not relate to a single general inventive concept under PCT Rule 13.1 because under PCT Rule 13.2, the inventions of Groups I-II lack the same or corresponding technical features. The Office Action indicates on page 2 that the inventions of Groups I-II "are related by the technical feature of a protein that is a signal for causing the expression of a protein, this feature is not special since it does not constitute an advance over the prior art." The Office Action indicates that WO 95/21248 teaches "an MP protein that is applied exogenously to facilitate protein expression and cell to cell movement in a multi-

cellular organism.” The Office Action further indicates that each Group has functions and components that are not required by the other Group and may be used for different processes.

Applicants respectfully disagree with the views of the Office Action that: (1) the inventions of Groups I-II do not relate to a single general inventive concept under PCT Rule 13.1 because the inventions of Groups I-II lack the same or corresponding technical features, and (2) Applicants’ invention does not constitute an advance over the prior art, particularly WO 95/21248. In contrast to the view of the Office Action, Applicants submit that the two independent claims, claims 1 and 27, are novel and inventive over WO 95/21248 because this document fails to disclose the method of claim 1 and the multi-cellular organism produced by said method (claim 27). Claims 1 and 27 and their respective dependent claims, each involve the same or corresponding technical features, particularly a protein that is capable of, leaving a cell and entering other cells of an organism (item (i) of claim 1; item (b) of claim 27) and causing expression of said protein in cells containing the heterologous nucleic acid encoding said protein (item (ii) of claim 1; item (c) of claim 27). WO 95/21248 fails to disclose such a method or multi-cellular organism involving these same or corresponding technical features of Applicants’ claimed invention. Accordingly, the instant application meets the unity of invention requirement of PCT Rule 13.1.

Concerning the position of Office Action that each Group has functions and components that are not required by the other Group and may be used for different processes, Applicants respectfully remind the Examiner that unity of invention practice, not restriction practice, applies to the present U.S. national stage application according to MPEP § 1893.03(d). See also, 37 C.F.R. § 1.499 (2006). Unity of invention is defined in 37 C.F.R. § 1.475(a) (2006) which provides that the “application shall relate to one invention only or to a group of inventions so linked as to form a single general inventive concept ('requirement of unity of invention').” As discussed in detail above, the instant application meets the requirement of unity of invention.

For the above reasons, Applicants submit that the Restriction Requirement is improper and should be withdrawn because the present application relates to a single general inventive concept under PCT Rule 13.1 and therefore, satisfies the requirement of unity of invention. Accordingly, Applicants respectfully request that the Examiner examine the Group I claims for all protein portions and the Group II claims together in the instant application.

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Amdt. dated 08/01/2007
Reply to Restriction Requirement of July 2, 2007

Should the Examiner have further questions or comments with respect to examination of this case, it is respectfully requested that the Examiner telephone the undersigned so that further examination of this application can be expedited.

It is not believed that extensions of time or fees for net addition of claims are required, beyond those, which may otherwise be provided for in documents accompanying this paper. However, in the event that additional extensions of time are necessary to allow consideration of this paper, such extensions are hereby petitioned under 37 CFR § 1.136(a), and any fee required therefore (including fees for net addition of claims) is hereby authorized to be charged to Deposit Account No. 16-0605.

Respectfully submitted,

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ELECTRONICALLY FILED USING THE EFS-WEB ELECTRONIC FILING SYSTEM OF THE UNITED STATES PATENT & TRADEMARK OFFICE ON August 1, 2007.